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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,744	04/01/2004	Hector Coronado	PA5346	5096
27574 7590 02/23/2009 KLEINBERG & LERNER, LLP 2049 CENTURY PARK EAST SUITE 1080 LOS ANGELES, CA 90067				
EXAMINER				
WINDELL, MARK R				
ART UNIT		PAPER NUMBER		
3635				
MAIL DATE		DELIVERY MODE		
02/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,744

Applicant(s)

CORONADO, HECTOR

Examiner

MARK R. WENDELL

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasell (US 5439749). Regarding claim 32, Klasell illustrates in Figures 1 and 3 a construction module comprising:

- A top and bottom panel (25 and 27) having an outer and inner surface and having a first plurality of thin sheet laminate layers bonded together. The examiner notes that in claim 2 of the prior art, it is stated that the layers are a composite board. It also states in column 5, lines 26-29 the composite board can be a high-density particle board, medium-density fiberboard, hardboard or other suitable wood composite material. This description generally includes composite wood structures as plywood and OSB which inherently have a layered composition, therefore the top layer has a laminate layered structure; and
- An intermediate panel (29) having an upper and lower surface and defining a cavity (see Figure 1 where the intermediate panel defines a

cavity in which the center window of the door is placed), the intermediate panel having a plurality of laminate layers bonded together.

Regarding claims 33-35, Klasell discloses layers being made from laminated veneer lumber (LVL) for decorative and waterproofing means (Column 1, lines 30-35, and Column 3, lines 34).

Regarding claims 36-38, Klasell discloses throughout the specification the top, bottom and intermediate layers being bonded to one another in such a manner:

- The inner surface of the top panel being bonded to the upper surface of the intermediate panel;
- The inner surface of the bottom panel being bonded to the lower surface of the intermediate panel (See Figure 3 also).

Regarding claims 39-41, it would have been obvious matter of design choice to modify Klasell by having the panels having the same number of laminate layers, since the applicant has not disclosed that producing the panels with the same number of laminate layers solves any stated problem or produces any unexpected results and it appears that the structure would perform equally well with the panels having different numbers of layers. However, the examiner notes that the 3 panels could be made from the same material as the prior art suggests that the panels and the core could be made from fiberboard or other suitable wood composite products (see column 5, lines 26-29 and

column 6, lines 1-8). Therefore, if the panels were made of the same material, which could be the case as described above, the number of layers within the panels would be the same.

Response to Arguments

Applicant's arguments filed 8/28/2009 have been fully considered but they are not persuasive. The applicant's argument with respect to the difference in the intended use of the prior art and the instant application is not persuasive. First off, Klasell teaches of a composite wood, layered structure (see abstract and claim 1. The layered structure is said to be useful in making doors and windows (see claim1 again); however in column 7, Klasell prefaces this "use claim" with this: "While the principles of this invention have been described in connection with specific embodiments, it should be understood clearly that these descriptions are made only by way of example and are not intended to limit the scope of the invention." It is clear when one reads the "Objects of Invention" section of the prior art that the main object of the invention is to provide a composite wood structure. The applicant should be careful not to impart limitations into the invention that do not exist. The prior art does not state or imply within the claims or description that the invention HAS to be hollowed out.

Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte Masham, 2 USPQ 2d 1647).

Lastly, the additional claim language added by the applicant referring to the panels being adapted to completely cover adjacent panels is shown to be met in Figures 12 and 13. The Figures illustrate a cross-section taken along line 3-3 of Figures 1 and 2. Figures 1 and 2 show a door and window structure; however the composite wood structure itself is not "hollow" and all layers cover each other completely as illustrated in Figures 12 and 13. Lastly, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (In re Hutchison, 69 USPQ 138). The layers of the panel, as shown in Figures 12 and 13, are capable of covering each other completely.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/M. R. W./
Examiner, Art Unit 3635
February 11, 2009